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Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ciena Corporation

Serial No. 75/794,637

Timothy J. Lyden of Hogan & Hartson L.L.P. for Ciena Corporation.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 123 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Cissel and Bottorff, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 8, 1999, applicant filed the above-identified application to register the mark "FASTPATH" on the Principal Register for "repair and/or replacement service for telecommunications equipment." The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in connection with these services in commerce.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that if applicant were to use the mark it seeks to register in connection with the services identified in the application, applicant's mark would so resemble the identical mark "FASTPATH," which is registered¹ for "integrated circuits, printed circuit boards, and telephony devices, namely, modems, cable modems, and integrated services digital network interfaces," that confusion would be likely because the marks are identical and the services with which applicant intends to use the mark are related to the goods listed in the cited registration.

Responsive to the refusal to register, applicant amended the recitation of services in the application to read as follows: "repair and replacement of proprietary telecommunication equipment modules." Applicant argued that, as reflected by this amendment, applicant's services are not related to the goods set forth in the cited registration closely enough for confusion to be likely.

The Examining Attorney was not persuaded by

¹ Reg. No. 2,188,210, issued on the Principal Register on September 8, 1998, to Cirrus Logic, Inc., a California corporation.

applicant's arguments, and the refusal to register under Section 2(d) of the Act was made final in the second Office Action. In support of her contention that the goods specified in the registration are commercially related to the services with which applicant intends to use the mark, the Examining Attorney made of record five third-party registrations wherein the goods listed include integrated circuits, printed circuit boards and/or modems, as well as repair services for telecommunication equipment. For example, one registration lists "communications interface cards" and "modems," in addition to "communications equipment installation, maintenance, and repair namely, telephones, computer networks and transceivers..." The next registration includes "modems," as well as "repair and maintenance services for electronic components and telecommunications components and equipment; and repair and maintenance services for communications components and equipment." The third registration includes both "integrated circuits" and "printed circuit boards," as well as "installation, maintenance and repair services in the field of telecommunication equipment." Yet another lists "computer circuit boards, modems, audio interface and conversion boards and circuits," "network interface boards, telephone and data transmission interface boards and

circuits," as well as "installation, maintenance and repair of ...telephone and telephone messaging systems, voicemail and voice messaging, electronic mail, automated attendant, interactive voice response, database access and processing, video, multimedia and fax processing systems." The final third-party registration made of record by the Examining Attorney includes "installation and maintenance services in the field of communications network systems," as well as "interface cards, printed circuit boards... and modems."

Based on these third-party registrations, the Examining Attorney argued that confusion is likely in the case at hand because customers for these goods and services are used to seeing the same entities use their marks on integrated circuits, printed circuit boards and/or modems, as well as in connection with repair services for telecommunication equipment.

In addition to maintaining the refusal based on the likelihood that confusion, the Examining Attorney also made final the requirement for applicant to amend the recitation of services by deleting the indefinite term "replacement."

Applicant responded to the final refusal and final requirement by amending the application to recite its services as "repair of proprietary fiber optic telecommunication equipment modules; installation of

replacement proprietary fiber optic telecommunication equipment modules," and arguing that confusion is not likely because the goods and services in question are "dissimilar." Applicant argued that its recitation of services, as amended, is limited to services in connection with fiber optic telecommunications equipment, which is inherently different from the goods identified in the cited registration.

Applicant requested reconsideration by the Examining Attorney, but concurrently filed a Notice of Appeal. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for reconsideration.

Upon reconsideration, the Examining Attorney accepted applicant's amended recitation of services, but maintained the refusal to register under Section 2(d) of the Act. Additional third-party registrations were attached to her Office Action in an effort to demonstrate the relatedness of registrant's integrated circuits, printed circuit boards and modems with and applicant's fiber optic telecommunication equipment repair and installation services. Four of these third-party registrations are based on use in commerce. The first two, owned by the same business, list "modems... fiber optic cable... fiber optic

connectors; integrated circuits" and "maintenance of telecommunications systems and telecommunications networks." The next lists "printed circuit boards" and "modems," as well as "installation, assembly and maintenance and repair of data communications circuits... and... fiber optic telecommunication equipment." The last one includes "printed circuit boards" and "modems," in addition to "installation, assembly and maintenance and repair of data communications circuits... and... fiber optic telecommunication equipment." This registration, however, is owned by a German corporation and based on Section 44 of the Act, rather than use in commerce.

After declining to pass the application to publication after reconsideration of it, the Examining Attorney then returned the file to the Board for resumption of action on the appeal. Both applicant and the Examining Attorney filed briefs, and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

In the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks and the similarity of the goods or services as they are set

forth in the application and the registration, respectively. If the marks in question are identical, as in the instant case, the relationship between the goods or services does not need to be as close in order to support a finding that confusion is likely as would be the case if there were differences between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981).

In view of the identity of the marks, our inquiry focuses on the relationship between the services recited in the application and the goods set forth in the cited registration. It is well settled that confusion may be found likely to occur from the use of the same or similar marks both for goods and for services involving those goods. In *re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). The goods and services do not have to be the same, or even directly competitive. All that is necessary in order to support a finding that confusion is likely is that the goods and services be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that both the goods and the services come from the same source. In *re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Such is the case now before us. While the goods and services are not identical, the third-party registrations made of record by the Examining Attorney demonstrate that other businesses have registered their marks for both some of the types of goods specified in the registration as well as for services of the kind applicant intends to render under the same mark. As noted above, these third-party registrations include references to telecommunications equipment, including integrated circuits, printed circuit boards and modems, all listed in the cited registration, and also to fiber optic telecommunication equipment repair and installation services. These registrations are probative of the relatedness of the goods at issue in this case in that they show that other businesses in the field have registered their own marks for both these goods and these services, and thus that both may be expected to emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1983); In re Mucky Duck Co., 6 USPQ2d 1467 (TTAB 1988).

Applicant argues to the contrary, that the services with which it intends to use the mark are rendered in different trade channels to different, sophisticated, customers, but these arguments are not supported with any evidence. The channels of trade are not limited in either

the registration or the application, nor is the Board presented with evidence relating to this factor or to the sophistication of the purchasers of either the goods listed in the registration or the services recited in the application. In any event, it is well settled that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable with respect to trademarks, or that they are somehow immune from source confusion caused by the use of the same or similar marks in connection with related goods or services. In *re* Decombe, 9 USPQ2d 1812 (TTAB 1988). As noted above, the record shows that other businesses have registered their marks for both goods and services similar to the ones in issue in this case. While this fact does not necessarily establish that the same customers purchase both, it does support the conclusion that potential purchasers have a basis upon which to understand that the use of one mark in connection with both indicates a common source.

Similarly unpersuasive is applicant's argument that the services identified in the application are "fundamentally different" from the goods set forth in the cited registration, in that the services will be rendered in the telecommunications field, whereas the goods are used

in the computer field. As the Examining Attorney points out, however, the goods listed in the registration include "telephony devices, namely, modems, cable modems, and integrated services digital network interfaces." In any event, it is not disputed that computers play integral roles in the rendering of telecommunications services.

In summary, confusion would be likely if applicant were to use the mark it seeks to register because the mark is identical to the cited registered mark and the services with which applicant intends to use it are commercially related to the products listed in the cited registration. Even if we were left with doubts regarding this conclusion, any such doubts would have to be resolved against applicant and in favor of the prior user and registrant. *J & J Snack Foods v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.